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JOHN E. HALAMKA, ESQ
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APR 29 2005

OFFICE OF PETITIONS

In re Application of	:	
Beckman	:	
Application No. 09/301,868	:	DECISION
Filing Date: 29 April, 1999	:	
Attorney Docket No. PA1.668FULL/640.CIP	:	

This is a decision on the petition filed on 21 December, 2004, alleging, *inter alia*, unavoidable delay under 37 C.F.R. §1.137(a).

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.137(a) is **DISMISSED**.

The Revocation/Power of Attorney submitted on 10 December, 2004, hereby is acknowledged and accepted. **However, the address of record is that set forth above, and, while Petitioner has suggested within his papers an indication that his current correspondence (mailing) address is something other than that listed in the Revocation/Power of Attorney, Petitioner has, as of this writing, failed to Notice the Office as to any such change. Therefore, Petitioner hereby is placed on notice that while a courtesy copy of this decision is being directed to the post office box address listed at the end of this decision, the address of record will remain that as listed above until such time as Petitioner properly Notices the Office of any change in that regard.**

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b)¹ (as to unintentional delay) must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)"; and/or "Petition under 37 C.F.R. §1.137(b)";
- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 30 March, 2001, with reply due absent extension of time on or before Monday, 2 July, 2001;
- the instant application went abandoned after midnight 30 June, 2001;
- the Office mailed a Notice of Abandonment on 6 November, 2001;
- although Petitioner discusses activities alleged to have occurred dating back to January 2001 through the filing of the instant petition on 10 December, 2004, there is no evidence of record that indicates Petitioner Noticed the Office with a Revocation/Power of Attorney prior to 10 December, 2004—contemporaneously with the filing of the instant petition;
- in fact, the instant petition recites: "I suspect that because I was not Attorney of record for 09/301,868, my request to change [the address of record in the application] was not honored";

¹ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

- Petitioner provides no documentary evidence, such as date-stamped receipt cards (see: MPEP §503²) to support allegations as to any filings—including Requests for Status;
- moreover, as of this writing Petitioner provides no sufficient basis for waiting almost 43 months to act to revive the instant application; and
- while Petitioner suggests at one point in the petition and the Power of Attorney submitted directs that his office address is as listed at the top of this decision, he indicates at another that his address P.O. Box 207, Palos Verdes Estates, CA 90274—however, there is no indication that a formal Notice of Change of Address has been filed of record herein, and Petitioner must cure that deficiency;
- Petitioner acknowledges that his response is to a final Office action, however, his reply is

² MPEP §503 provides in pertinent part:
§503 Application Number and Filing Receipt

* * *

A return postcard should be attached to *each* patent application for which a receipt is desired. It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO). It should be recognized that the identification of an application by application number does not necessarily signify that the USPTO has accepted the application as complete (37 C.F.R. §1.53(a)).

* * *

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the post-card initialed by the person receiving the items. Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO. (Emphasis supplied.)

not a proper reply as submitted with the instant petition to a final Office action,³ and Petitioner is directed to the regulations at 37 C.F.R. §1.114;

- Petitioner styles his petition as one alleging "unavoidable delay" to be considered under 37 C.F.R. §1.137(a), and buries within the paper what appears to be an alternative plea for relief under the provisions of 37 C.F.R. §1.137(b)—*i.e.*, alleging unintentional delay—and Petitioner is directed to the regulations at 37 C.F.R. §1.4(d);
- Petitioner suggests but does not support allegations to be considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁴

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁵

Delays in responding properly raise the question whether delays are unavoidable.⁶ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁷

³ A proper reply is an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or a CPA or RCE (with fee and submission). (See: MPEP §711.03(c).)

⁴ 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁵ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁶ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁷ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

And the Petitioner must be diligent in attending to the matter.⁸ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁹))

As to Allegations to Seek

Withdrawal of the holding of abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.¹⁰

Petitioner has made no documented showing in support of such allegations.

Accordingly, the petition to withdraw the holding of abandonment as considered under 37 C.F.R. §1.181 must be and hereby is dismissed.

As to the Allegations of Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and—where appropriate—a terminal disclaimer and fee if the application was filed before 8 June, 1995.

Petitioner has failed to satisfy the “showing” and the “reply” requirements under the regulation.

As to the Allegations of Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement of unintentional delay (however, there may be a greater requirement if, as here, the

⁸ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁹ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

¹⁰ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

delay is of such an extended period), a proper reply, and--where appropriate--a terminal disclaimer and fee if the application was filed before 8 June, 1995.

Petitioner has failed to satisfy the "showing" and the "reply" requirements under the regulation.

CONCLUSION

The petition as considered under 37 C.F.R. §1.181 as a request to withdraw the holding of abandonment is **dismissed**.

The petition under 37 C.F.R. §1.137(a) is **dismissed**.

The petition under 37 C.F.R. §1.137(b) hereby is **dismissed**.

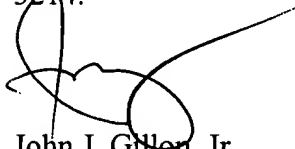
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 P.O. Box 1450
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By FAX: IFW Formal Filings
 (703) 872-9306
 ATTN.: Office of Petitions

By hand: Mail Stop: Petition
 Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to read "John J. Gillen, Jr.", with a long, sweeping horizontal stroke extending to the right.

John J. Gillen, Jr.
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cc:

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